II. REMARKS

Support for Amendments to the Claims

The amendments to the claims presented herein are fully supported by the specification

and drawings as originally filed. More specifically, the limitation "the secondary number being

associated with a consumer-defined level of access to the centralized personal data base" is

supported at least by Paragraph [0024] ("The user selects the information that is to be accessible

to a merchant (**740**). In other words, the user decides what information can be accessed by a

merchant using the primary number in combination with each particular secondary number the

user will provide").

Accordingly, no new matter is introduced.

Claim Rejections – 35 USC § 101

The Examiner rejected claims 1-13, 18, and 21-26 under 35 U.S.C. § 101, stating the

claimed invention is directed to non-statutory subject matter. Applicant respectfully traverses

these rejections.

35 U.S.C. § 101 provides that "any new and useful process, machine, manufacture, or

composition of matter" is eligible for patent protection, subject to other conditions and

requirements of patent law.

Claims 2-13 and 24-26 depend from claim 1. Claim 1 is drawn to "a programmable

apparatus." A programmable apparatus is a machine – subject matter that is specifically

identified as statutory in 35 U.S.C. § 101. Therefore, claims 1-13 and 24-26 are statutory.

Claims 21 and 22 depend from claim 18. Claim 18 is drawn to "a method for remotely

providing personal information from a centralized personal data base." A method is a process –

subject matter that is specifically identified as statutory in 35 U.S.C. § 101. Therefore, claims 18, 21, and 22 are statutory.

Claim 23 is drawn to "a computer readable memory" and includes the limitation "a computer program stored in said storage medium containing instructions to cause the computer to..." Thus, claim 23 recites a program stored in a computer readable storage medium, which is a physical structure. "When a computer program is recited in conjunction with a physical structure, such as a computer memory, USPTO personnel should treat the claim as a product claim." MPEP § 2106.01. Thus, claim 23 is a product claim, and products are specifically identified as statutory subject matter in 35 U.S.C. § 101. Therefore, claim 23 is statutory.

Additionally, the Examiner contends that "claims recite only perfunctory recitation of functional material (database, programmable apparatus, etc.). Aside from this, the claims recite only nonfunctional descriptive material." Office Action, page 2. However, it is improper for the Examiner to disregard the functional material in the claims and then reject the claims for containing "only nonfunctional descriptive material." The Examiner cannot disregard claim limitations that the Examiner considers "perfunctory." Instead, "when evaluating the scope of a claim, every limitation in the claim must be considered. USPTO personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation." MPEP § 2106.01. Accordingly, it is improper for the Examiner to ignore claim limitations and evaluate the rest of the claim in isolation.

For all of the foregoing reasons, Applicant respectfully requests that these rejections be withdrawn.

Claim Rejections – 35 USC § 103

The Examiner rejected claims 1-13, 18, and 21-26 under 35 U.S.C. 103(a) as being unpatentable over Passport (Odds & Ends January 2000, Vol. 8, Issue 1, The Safety Net of Passport Your Ticket for Electronically Transporting Your Wallet Online, hereinafter "Passport"). Applicant respectfully traverses these rejections.

The Examiner contends that the claims are obvious in light of the Passport reference. Office Action, page 5. However, to establish a *prima facie* case of obviousness, the Examiner must show at least that all of the claim limitations are taught or suggested by the prior art. MPEP § 2143.03 citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

The Examiner has not established a *prima facie* case of obviousness in light of Passport because the Examiner has not met the burden of proving that Passport teaches or suggests all of the claim limitations. More specifically, and without limitation, Passport does not teach or suggest the use of <u>three distinct numbers</u> to control access by multiple parties to a personal database. As explained in the specification at [0021]-[0024], these three distinct numbers have the following properties:

1.) The basic number is known to the consumer and not to the merchant.

2.) The primary number is known to the consumer and to a merchant to whom it is given.

3.) The secondary number is only known to the merchant. The consumer selects the information that is to be accessible with the secondary number.

As amended, claim 1 requires a "centralized personal database being accessible by a consumer having a basic number and a primary number and accessible to a merchant having the primary number and a secondary number, the secondary number being associated with a

consumer-defined level of access to the centralized personal data base." Passport does not teach

or suggest a centralized personal database that is accessible by a consumer with a basic number

and a primary number, and by a merchant with the same primary number and a secondary

number, wherein the secondary number is associated with a level of access to the database

defined by the consumer.

The Examiner contends that Passport (section "Step 2") teaches a centralized personal

database accessible by a consumer with a basic number and a primary number, and accessible by

a merchant having the primary number and a secondary number. Office Action, pages 4-5. Step

2, however, merely discusses a consumer signing into a Passport-enabled site. Nowhere in Step

2 does it say how the consumer signs in, or whether the consumer signs in using means of

identification analogous to a basic number and a primary number, as those terms are defined in

the specification. Additionally, Step 2 fails to disclose a consumer-defined level of access to the

database being associated with a secondary number held by a merchant. Although Step 2

discloses the consumer selecting which information is sent to the merchant, it does not disclose

the merchant itself having access to a central personal database, wherein the merchant's level of

access is defined by the consumer. A consumer selectively sending information to a merchant is

not the same as giving the merchant a consumer-defined level of access to a database.

The Examiner also argues that Step 4 of Passport teaches "the consumer creates the

secondary number and provides the primary number and the secondary number to the merchant."

Office Action, page 5. Step 4 of Passport is set forth in its entirety below:

> *Step 4: The merchant begins completing the order. This step doesn't use any*
> *fancy new technology; the merchant simply fulfills this order just like any other order.*
> *The customer's profile data, however, might be stored in the merchant's database (the e-*
> *commerce site decides whether to store the data, but it's a good bet that all of them will*
> *use it to learn more about customer demographics).*

> *We advise all consumers to read each e-commerce site's privacy policy. All Passport merchant sites post privacy statements that tell consumers what information they collect, how they use it and share it, what security procedures exist, and how to correct inaccuracies.*

Applicant respectfully asserts that no portion of Step 4 of Passport teaches or suggests the claim language identified above. Step 4 does not teach or suggest the consumer creating a secondary number and providing a primary and secondary number to a merchant.

The Examiner further argues that Step 4 of passport teaches "the merchant is prohibited from modifying the account data in the account". Office Action, page 5 ("merchant fulfills order, of course merchant cannot modify the personal information of the consumer"). As seen above, Step 4 discloses nothing about prohibiting a merchant from modifying data in an account. The Examiner's assertion that "of course merchant cannot modify the personal information of the consumer" is conclusory and is not supported by specific citations of Passport with corresponding explanation pointing out why the citation allegedly teach the claim limitation. For all of these reasons, Passport does not teach or suggest every limitation of claim 1, and therefore a *prima facie* case of obviousness does not exist.

Regarding claims 4, 7, 10, 11, 13, and 26 – all of these claims depend from claim 1. As explained above, Passport does not teach every limitation of claim 1, and therefore Passport also fails to teach every limitation of these claims. Additionally, the Examiner rejected these claims stating "see section step 2, step 3, step 4 – the numbers of merchant and consumer are handled by Passport." Office Action, page 5. However, as explained above, Passport does not teach the use of these numbers at all. Accordingly, a *prima facie* case of obviousness does not exist.

Regarding claims 5, 6, 8, 9, 12, 24, and 25 – all of these claims depend from claim 1. As explained above, Passport does not teach every limitation of claim 1, and therefore Passport also

fails to teach every limitation of these claims. Accordingly, a *prima facie* case of obviousness does not exist.

Regarding claims 18, 21, 22 – as explained in response to the rejection of claim 1, Passport fails to teach or suggest at least "a secondary number associated with a consumer-defined level of access to the centralized personal data base" as required by claim 18. Claims 21 and 22 depend from claim 18, and therefore a *prima facie* case of obviousness does not exist for any of these claims.
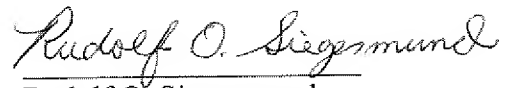
Regarding claim 23 – as explained in response to the rejection of claim 1, Passport fails to teach or suggest at least "the secondary number being associated with a consumer-defined level of access to the centralized personal data base." Therefore, a *prima facie* case of obviousness does not exist.

In summary, the Passport reference does not teach or suggest every limitation of these claims. Accordingly, Applicant respectfully requests that all rejections be withdrawn.

Conclusion

Applicant submits that the claims are in condition for allowance.

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